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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,577	12/21/2001	Peter Schertl	Mo6856/LeA 33,769	1797

7590 05/31/2006

LANXESS CORPORATION
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PITTSBURGH, PA 15275-1112

EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,577

Applicant(s)

SCHERTL ET AL.

Examiner

Roberto Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,9-11,16,19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,9-11,16,19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1, 3-5, 7, 9-11, 16, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirooka et al. (US 3,700,648) for the reasons set forth in item 3 of the Office action mailed 9/14/2005.

Applicants' arguments filed 3/14/2006 have been fully considered but they are not persuasive. Applicants have incorrectly stated: "The examiner concedes that Hirooka fails to disclose the specific transition metal component or the radical producer of the Applicants' claimed invention." In fact, the previous Office action stated that while such species are not exemplified, they are in fact disclosed in the reference. Specifically, the previously cited species of acetylacetonate (acac) complexes at col. 11, lines 13-18 disclose transition metal species within the claimed scope. The acac ligand is a monoanionic 2-dentate ligand, and therefore this ligand is within the scope of both L and Q. Since the cited reference species have at least two acac ligands, the first ~~may~~ functions as L and the second functions as Q. There is nothing in the claims which requires L and Q to be different, and therefore the reference species are within the scope of transition metal compounds required in the claims. Regarding applicants' argument directed to additional "required" features of the Hirooka process, such argument is not relevant to the instant rejection because the claimed process is open-ended and wholly unlimited regarding additional unrecited features.

Applicants have amended claim 21 to depend from claim 11, which has already been rejected over Hirooka. The reference is primarily concerned with the description of the process and the polymer, and has not disclosed any particular applications for the disclosed copolymer. However, in view of the fact that the vast majority of synthetic polymers from olefinically unsaturated monomers are intended for making some type of molding, official notice is taken that one of ordinary skill in the art would be motivated to use of copolymer of Hirooka as a minor or major component of any type of molding.

4. Claims 5, 7, 9, 10, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipian et al. (US 6,455,650) for the reasons set forth in item 4 of the Office action mailed 9/14/2005.

Applicant's arguments filed 3/14/2006 have been fully considered but they are not persuasive. Applicants' implication that the reference does not disclose copolymerization of polar and non-polar monomers is clearly incorrect. Most of the reference example polymerizations are copolymerizations of polar and non-polar norbornenes, and the descriptions at col. 29-37 disclose a wide array of polar and non-polar monomers for copolymerization. Regarding catalyst, applicants' assertions that the reference fails to disclose the required catalyst are also incorrect. Specifically, structures I, II, III, Va, Vb through Vj are all within the scope of catalyst; furthermore, the allyl complexes of VI would also appear to be within the claimed scope.

Art Unit: 1713

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

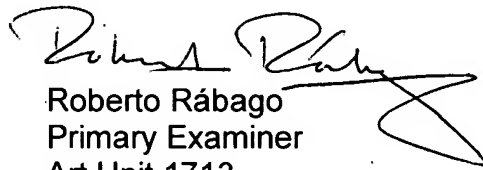
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roberto Rábago
Primary Examiner
Art Unit 1713

RR
May 18, 2006